

137522-1

REMARKS

Claims 1, 3-4, and 6-27 are pending in the present Application. No claims have been canceled or amended, leaving Claims 1, 3-4, and 6-27 for further consideration. Reconsideration and allowance of the claims are respectfully requested in view of the following remarks.

Interview Summary

Applicants thank Examiner Boykin for conducting a telephone interview with Applicants' representative Joel T. Charlton on February 3, 2005. During that interview, the rejection made under 35 U.S.C. § 112, first paragraph in relation to Claims 1 and 3-15 was discussed. More particularly, Applicants' representative highlighted that no new matter was added, since the amendments to Claims 1 and 4 contained the language presented in originally filed Claims 2 and 4. Further, during that interview, Applicants' representative highlighted a number of other typographical errors in the Office Action and requested that the finality of the office action be withdrawn.

Finality of the Office Action

Applicants respectfully submit that the finality of the Office Action is improper for at least the reason that the Examiner is introducing a new rejection (i.e., claim rejection under 35 U.S.C. § 112, First Paragraph) that was neither necessitated by Applicants' amendment of the claims nor based on information submitted in an information disclosure statement. (MPEP 706.07(a)). More particularly, the allegation of new matter is improper for at least the reason that the "adjusting" language was originally present in the claims. As such, Applicants' previously submitted amendment is not new matter, and therefore cannot necessitate the rejection.

However, Applicants believe this point is moot, since the application is allowable over the art made of record in light of Applicants' remarks.

Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1, 3-4, and 6-15 stand rejected under 35 U.S.C. § 112, First Paragraph, as allegedly failing to comply with the written description requirement. More particularly, the Examiner states that "applicants' explanation of what constitutes an "adjustment" has not been

137522-1

adequately disclosed in the specification. Applicants have merely stated in the specification that an 'adjustment is made without designating what constitutes the specific 'adjustment'".

Applicants respectfully traverse this rejection.

Applicants respectfully submit that a new matter rejection under 35 U.S.C. § 112, First Paragraph is improper for at least the reason that the "adjusting" language was originally present in the specification and claims (i.e., amended Claim 1 is original Claim 2 rewritten as an independent claim and Claim 4 is original Claim 4 rewritten as an independent claim). The term "adjusting" in relation to the OH group concentration of polycarbonate is supported throughout the specification (e.g., at least in paragraphs [0055], [0060], [0064], [0068], and [0070]). Further, the term "adjusting" is a term that is readily understood by those skilled in the art. For example, the term "adjusted" appears in paragraph [0018] of U.S. Published Patent Application No. 2003/0065130, which was cited by the Examiner in making the rejections set forth below.

For at least these reasons, Applicants respectfully submit that the claimed invention was described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Accordingly, Applicants respectfully submit that this rejection is improper and request that the rejection be withdrawn.

Claim Rejections Under 35 U.S.C. § 102(e)

Claims 1, 3-4, and 6-27 stand rejected under 35 U.S.C. § 102(e), as allegedly anticipated by U.S. Published Patent Application No. 2003/0065130 to Hahnsen et al. Applicants respectfully traverse this rejection.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

Hahnsen et al. teach that

the condensation of polycarbonate, characterized in that polycarbonates may be condensed in the melt, usefully with the addition of bisphenols or oligocarbonates with OH terminal groups to accelerate the reaction, optionally using catalysts to obtain polycarbonates, which have a higher molecular weight than the starting polycarbonate.

(Paragraph [0012]).

137522-1

Further, Hahnsen et al. teach that "the polycarbonate used either already has an average concentration of phenolic terminal groups of over 100 ppm OH...or this is adjusted in the melt by adding a bisphenol...or oligocarbonates having terminal OH groups." (emphasis added; Paragraph [0018]). Absent in Hahnsen et al. is any teaching (express or inherent) of adjusting the OH group concentration of the polycarbonate waste component, wherein the OH group concentration is adjusted before being subjected to either of the transesterification reaction or the polycondensation reaction.

Accordingly, Hahnsen et al. at least fail to teach adjusting the OH group concentration of the polycarbonate waste component before the polycarbonate waste component is subjected to either of the transesterification reaction or the polycondensation reaction. Rather, Hahnsen et al. teaches adjusting the OH as part of the condensation reaction. For at least this reason, independent Claim 1 is not anticipated and is allowable over Hahnsen et al. Moreover, as dependent claims from an allowable independent claim, Claims 3 and 6-15, are, by definition, also allowable.

With regards to independent Claim 4, it is noted that Hahnsen et al. at least fail to teach adjusting the OH group concentration of the polycarbonate waste component during the transesterification reaction. More particularly, Hahnsen et al. teach throughout their disclosure the condensation of polycarbonate and teach that bisphenols or oligocarbonates with OH terminal groups accelerate the condensation reaction (See paragraph [0012]). In other words, Hahnsen et al. teach that polycarbonate can initially be made by an interfacial or melt transesterification process and later condensed to form a new polycarbonate. Absent is any teaching of adjusting the OH group concentration of polycarbonate waste component during the transesterification reaction. Again, as noted above, Hahnsen et al. appear to only teach adjusting the OH terminal groups as part of a condensation reaction. For at least this reason, independent Claim 4 is not anticipated and is allowable over Hahnsen et al.

With regards to independent Claim 16, the Examiner alleged that

the reference [Hahnsen et al.] discloses a process for making a high molecular weight (co)polymer resin comprising (i) obtaining at least one member selected from the group low molecular weight residue (weight average molecular weight 15,000 to 30,000) of aromatic (co)polycarbonate production, this would be inclusive of applicants prepolymerization composition. Further the mixing of

137522-1

the waste composition and the prepolymerization composition may be anticipated by the recylate disclosed in the reference.
("Final" Office Action, page 9).

First, it is noted that Hahnsen et al. fail to teach "introducing a dihydroxy compound and a carbonate diester to a mixing tank to form a mixing tank composition". Rather, Hahnsen et al. teach a process where at least one member of "aromatic (co)polycarbonate production, waste of (co)polycarbonate production, remainders of (co)polycarbonate production and (co)polycarbonate recylate" are melted in a vessel to form a melt. (Abstract). In other words, Hahnsen et al. is silent on a process of recycling polycarbonate where a prepolymerization composition is first formed from a dihydroxyl compound and a carbonate diester, which is combined with a melted polycarbonate waste component and then polymerized. Hahnsen et al., at, best teach making polycarbonate by melting polycarbonate.

Hahnsen et al. do not teach the complete process of making a prepolymerization composition that is combined with the melted polycarbonate waste component. In other words, Hahnsen et al. teach a method of making polycarbonate from existing polycarbonate. For at least the reason that Hansen et al. fail to teach the claimed elements relating to forming a prepolymerization composition and combining the prepolymerization composition with the melted polycarbonate waste, Applicants' independent Claim 16 is not anticipated and is allowable over Hansen et al. Moreover, as dependent claims from an allowable independent claim, Claims 17-27, are, by definition, also allowable.

Additionally, even if the Examiner were to maintain the rejection with regards to independent Claim 16, additional patentable distinct features can be found in the dependent claims. For example, Claim 18 discloses that the "OH group concentration is adjusted before combining the prepolymerization with the melted polycarbonate waste component". As noted above, Hahnsen et al. teach adjusting the OH group concentration in the melt, and is completely silent to adjust the OH group concentration off the polycarbonate waste component before combining the polycarbonate waste component with a prepolymerization component. For at least this reason, dependent Claim 18 is not anticipated and is therefore allowable over Hahnsen et al. independent of finding independent Claim 16 allowable.

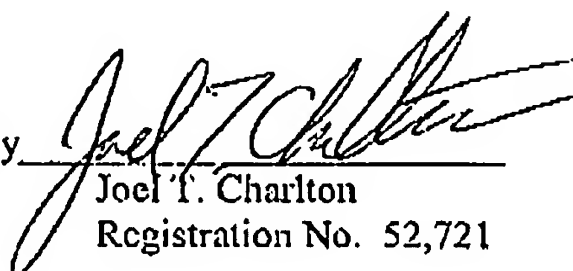
137522-1

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0862.

Respectfully submitted,

CANTOR COLBURN LLP

By 
Joel F. Charlton
Registration No. 52,721

Date: March 15, 2005
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No.: 43248